

Application No. 10/802,640
Amendment dated June 26, 2007
Reply to Office action of March 19, 2007

REMARKS/ARGUMENTS

Claims 1, 4-7, 16 and 20 were rejected under 35 U.S.C. 102 (b) as being anticipated by Bechtel et al, U.S. patent 5, 371,991 ('991). Claims 2-3, 8, and 17-19 were rejected under 35 U.S.C. 103(a) as being obvious over Bechtel in view of Schumacher et el, U.S. Patent 4,121,798. Claim 1 is cancelled. Claim 21 is presented. Claims 2-8 are amended to depend from Claim 21. Claims 9-15 stand withdrawn without prejudice to Applicant's rights with respect to further prosecution of those claims. Claim 16 is amended. The claims as amended and presented are believed to distinguish structurally from the art of record and to be unobvious over the art, whether the art is considered singly or in combination.

Applicant has devised an extremely successful device used to quickly and efficiently set up and/or remove, in conjunction with what are commonly known as retail displays or display towers, attention attracting items in the form of small signs or panels often used by department stores and similar merchants to attract the attention of their customers to a particular display of goods. In one form, the invention comprises an elongated clip with a unitary body having an intermediate section and a first pair of opposed arms, the body having an interior surface and an interior surface arranged to define an elongated open mouth axially extending channel and a second pair of opposed arms formed along the external surface proximate one of the arms of the first pair of opposed arms. The claims have been amended to more specifically require that

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the channel mounts to the display while the second pair of opposed arms receive at least a portion of the display panel.

None of the art of record discloses similar structure or gives a similar result. Bechtel '991, relied upon by the Examiner in the context of the original claims, discloses a re-bar clamp for use in forming concrete footings that require the reinforcing steel rods to be spaced upwardly at a predetermined height above ground so that when the concrete is poured into the footings, the reinforcing bars will be completely encapsulated by the concrete. It is respectfully suggested that it is only with the hindsight knowledge provided by Applicant's disclosure that one skilled in the art would even consider the '991 patent for any purpose related to Applicant's invention, and even with that hindsight, the '991 structure will not function for Applicant's purpose without substantial modification. But that need modification only is provided by Applicant's disclosure, and not by the art of record.

The M.P.E.P. provides at §2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in ... claim." *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Because there is no suggestion in the '991 patent to provide a clip a first set of opposed arms which in part define an axially extending channel for receiving at least a

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portion of a merchandise display, either along or in conjunction with a second pair of opposed arms located proximate to one of the arms of the first part, the second pair of opposed arms receiving a portion of a display panel as required by the claims, reconsideration and withdrawal of the rejection under 35 USC 102 are respectfully requested.

It is respectfully suggested that the claim rejections based on 35 U.S.C. 103 are also without merit. Schumacher, 4,121,798 was relied upon by the Examiner, again in the context of the original claims, to show an outward flare at the ends of each of the pair of arms. However, all of the claims, as amended and presented, require more. For example, as indicated above the claims all require an elongated open mouth channel defined by an intermediate section and a first pair of opposed arms for receiving at least a portion of a merchandise display, and a second pair of opposed arms located proximate to one of the arms of the first pair of opposed arms for receiving at least a portion of a display panel. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure." MPEP § 2143.

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Further, "a statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP §2143.01(IV) (emphasis in original).

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." MPEP §2143.01(I) (Citations omitted)

The recent KSR case (KSR Int'l. Co. v. Teleflex, Inc. No 04-1350 (U.S. Apr. 30, 2007) is not believed to have altered the requirements. See U.S.P.O MEMORANDUM attached as Exhibit 1.

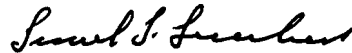
The art indicated as pertinent to Applicant's disclosure and not relied upon by the Examiner is noted as art of interest.

For the reasons that the claims as amended and presented are believed to distinguish structurally from the art of record, whether that art is considered singly or in

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combination, entrance of the amendment, reexamination of claims, and passage of the case to issue are respectfully requested.

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